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Paper 9

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**MAY 22 2003**

**OFFICE OF PETITIONS**

In re Application of  
Didomenico, et al  
Application No. 09/709,935  
Filed: 13 November, 2000  
Attorney Docket No. 23439-054-402

: DECISION ON PETITION

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This is a decision on the petition under 37 C.F.R. §1.47(b),<sup>1</sup> filed 4 September, 2001, but not received into the Office of Petitions until this writing.

The Office regrets the delay in addressing this matter.

The petition is **DISMISSED**.

**NOTE:** Any petition (and fee) for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(b)" and may include an oath or declaration executed by the inventors.

Thereafter there will be no further reconsideration. Failure to respond will result in abandonment of the application.

<sup>1</sup> The regulations at 37 C.F.R. §1.47, in pertinent part:

**§1.47 Correction of inventorship in a patent application, other than a reissue application.**

\* \* \*

(b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in §17(l), and the last known address of all of the inventors. The Office shall, except in a continued prosecution application under §1.53(d), forward notice of the filing of the application to all of the inventors at the addresses stated in the application and publish notice of the filing of the application in the *Official Gazette*. An inventor may subsequently join in the application on filing an oath or declaration complying with §1.63.

### BACKGROUND

The record indicates:

- this application was filed on 13 November, 2000, without an executed oath or declaration by the named inventors John Didomenico (Mr. Didomenico), Craig S. Rendahl (Mr. Rendahl) and James H. Johnson (Mr. Johnson);
- accordingly, a Notice of Missing Parts was mailed on 2 March, 2001;
- in response to the Notice of Missing Parts, Petitioner filed on 4 September, 2001, and resubmitted via FAX on 7 December, 2001, *inter alia*, a request and fee for a four- (4-) month extension of time, the surcharge and the instant petition;
- contrary to the statement therein, the petition is supported by no documentation evidencing:
  - mailing of the entire application to Mr. Didomenico, Mr. Rendahl and Mr. Johnson Mr. Morales, or
  - the alleged assignment by them of instant application with recordation reel/frame and certificate under 37 C.F.R. §3.73; and
- the application is not signed by the authorized official of the assignee.

### ANALYSIS

Petitioner has failed to establish its proprietary interest and that the inventors refuse to sign, cannot be found to sign the declaration (the proof of the pertinent events must be made by a statement of someone with first hand knowledge of the events) or cannot be reached.

A copy of the entire application papers must be sent to the last known address of the non-signing inventor(s) with a request that he/she sign the declaration for the patent application. A forwarding address should be requested, if the papers are returned, and other attempts to locate the inventor, e.g. through e-mail or the telephone continue to fail, then applicant will have established that the inventor(s) cannot be reached.

The submission must contain documentation evidencing that the entire application and the oath or declaration were sent to the inventors at his/her last know address. Such evidence should included a copy of the transmittal letter and a copy of the shipping waybill and the shipper's indication of delivery, refusal, or other non-delivery conditions.

An oath or declaration for the patent application in compliance with 37 C.F.R. §1.63 and §1.64 must be presented. The declaration must set forth the inventor's residence, citizenship and post office address. (An oath or declaration in compliance with 37 C.F.R. §1.63 and §1.64 signed by the Rule §1.47 applicant is required.)

Moreover, Petitioner's Counsel must set forth in his/her statement their attestation that he/she has inquired into the matter and believes all of the information submitted to be correct.

Further correspondence with respect to this matter should be addressed as follows:

Further correspondence with respect to this matter should be addressed as follows:

By mail: (Effective 1 May, 2003)  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450<sup>2</sup>

By FAX: (703) 308-6916  
ATTN.: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23  
2201 South Clark Place  
Arlington, VA 22202

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.



John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions

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<sup>2</sup> To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at [www.uspto.gov](http://www.uspto.gov).